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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,015	08/30/2001	Tongbi Jiang	3086.7US (96-1006.7)	9929

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EXAMINER

CHAMBLISS, ALONZO

ART UNIT PAPER NUMBER

2827

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/944,015

Applicant(s)

JIANG ET AL.

Examiner

Alonzo Chambliss

Art Unit

2827

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 4-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 14 February 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Amendment B filed on 2/14/03 has been fully considered and made of record in Paper No. 9.

Response to Amendment

2. Applicant's arguments filed on 10/4/02 in Paper No. 7 have been fully considered but they are not persuasive.

Applicant alleges that in the present instance, no statutory double patenting under 35 U.S.C. 101 exists between the presently claimed invention of amended independent claims 1 and 3 of the present application and independent claims 1 and 3 of the U.S. 6,316,824. This argument is respectfully deemed to be unpersuasive because the amendment of adding **for attachment in one of a conventional die attach to lead frame connect process and a LOC connect process** does not render the claim not identical to the subject matter in the patent. Since, a connector (i.e. bonding wire) is an attachment means for a conventional die to a lead frame. Also, the LOC connect process is present in the claim since the plastic lead frame is attached to the die by an adhesive. Furthermore, the test for a statutory double patenting is: Is the same invention being claimed twice? The " same invention " means identical subject matter not a claim having identical phrases or words. Therefore, since the connector (i.e. bonding wire) is a conventional attachment means between a die and a lead frame and a LOC connect process includes a lead frame attached to the top of a die by an adhesive, the claim is properly rejected under 35 U.S.C. 101.

Double Patenting

3. In claim 1 of the instant application the word " semiconductor " on line 2 is added to the claim. However, the IC die (i.e. integrated circuit die) of U.S. Patent 6,316,824 is a semiconductor die. In claim 1 of the instant application the phrase " at least one bond pad thereon " on line 2 was replaced with " a plurality of bond pads thereon " in U.S. Patent No. 6,316,824. However, at least one bond pad is present in a plurality of bond pads. In claim 1, of the instant application the phrase **for attachment in one of a conventional die attach to lead frame connect process and a LOC connect process** is added to the claim. However, a connector (i.e. bonding wire) is an attachment means for a conventional die to a lead frame. In claim 3, of the instant application the word " semiconductor " on line 2 is added to the claim. However, the IC die (i.e. integrated circuit die) of U.S. Patent 6,316,824 is a semiconductor die. In claim 3 of the instant application the phrase " at least one bond pad thereon " on line 2 was replaced with " a plurality of bond pads thereon " in U.S. Patent No. 6,316,824. However, at least one bond pad is present in a plurality of bond pads. In claim 3, of the instant application the phrase **for attachment in one of a conventional die attach to lead frame connect process and a LOC connect process** is added to the claim. However, a connector (i.e. bonding wire) is an attachment means for a conventional die to a lead frame. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1 and 3 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 3 of prior U.S. Patent No. 6,316,824. This is a double patenting rejection.

The prior art made of record and not relied upon is cited primarily to show the product of the instant invention.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning the communication or earlier communications from the examiner should be directed to Alonzo Chambliss whose telephone number is (703) 306-9143. The fax phone number for this Group is (703) 308-7722 or 7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-7956.

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